

REMARKS/ARGUMENTS

This case has been carefully reviewed and analyzed in view of the Office Action dated 9 June 2006. Responsive to that Office Action, Claims 2 and 5 are amended for further prosecution with the other pending Claims. With such amendment of Claims, there is a further clarification of the pending Claims' recitations. In the Office Action, the Examiner rejected Claims 2, 3 and 5 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. In response to this rejection, the appropriate Claims have been amended and now particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In the Official Action, the Examiner rejected Claims 1-5 under 35 U.S.C. § 102(a) as being anticipated by the Liaw, et al. Publication (Polymer Preprints 2003, 44 (1), 945). In response to this rejection, Applicant submits Declarations requesting that the Inventorship be changed due to cancellation of Claims due to the restriction requirement from 22 March 2006. The Declaration states that the true Inventors of Claims 1-5 are Der-Jang Liaw and Ching-Chang Huang, the authors of the cited reference. The filing of the subject Patent Application was within one year of the Publication date of the cited Publication and therefore is not proper as prior art.

Being filed concurrently with this Amendment is:

- (a) Request to Correct Inventorship under 37 CFR 1.48 (b); and
- (b) Declaration in Support of the Request to Correct Inventorship.

The other reference cited by the Examiner but not used in the rejection is further remote from the subject Patent Application when patentability considerations are taken into account.

It is now believed that the subject Patent Application has been placed in condition for allowance, and such action is respectfully requested.

If there are any further charges associated with this filing, the Honorable Commissioner for Patents is hereby authorized to charge Deposit Account #18-2011 for such charges.

Respectfully submitted,
For: ROSENBERG, KLEIN & LEE



Morton J. Rosenberg
Registration #26,049

Dated: 10/14/2006

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MR1035-1387



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

Applicant : Der-Jang Liaw :
Serial No. : 10/777,054 : Art Unit #1713
Filed : 13 February 2004 : Examiner: F. M. Teskin
Title : FUNCTIONAL NORBORNENES AS
INITIATORS FOR RADICAL POLYMERIZATION,
THEIR POLYMERIC DERIVATIVES AND A
PROCESS FOR PRODUCING THE SAME

REQUEST TO CORRECTION INVENTORSHIP UNDER 37 CFR 1.48(b) TO
ACCEPT FEWER INVENTORS DUE TO CANCELLATION OF CLAIMS

Mail Stop NO FEE
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We, Der-Jang Liaw; Ching-Cheng Huang; Jing Yang Ju; and Jiun-Tyng Liaw,
hereby make request as follows:

- (1) That we are the actual inventors of the above-referenced patent application
as filed at the U.S. Patent and Trademark Office;
- (2) That the patent application was filed with Claims 1-27;
- (3) That responsive to a Restriction Requirement from the U.S. Patent and
Trademark Office, Claims 1-5 were chosen for further prosecution in this case;
- (4) That the actual inventors of Claims 1-5 are Der-Jang Liaw and Ching-
Cheng Huang;
- (5) That this Request is being made to delete the inventors, Jing Yang Ju and
Jiun-Tyng Liaw from further prosecution of Claims 1-5;

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Appln. No. 10/777,054

(6) That a check in the amount of \$130.00 is attached to the Amendment which accompanies this Request for processing fees under 37 CFR 1.17(i).

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Oct. 14, 2006

Dated

Oct. 10, 2006

Dated

2006/10/05

Dated

2006/10/12

Dated

Der-Jang Liaw

Der-Jang Liaw

Ching-Cheng Huang

Ching-Cheng Huang

Jin-Ting Yang

Jing-Yang Ju

Jiun-Tyng Liaw

Jiun-Tyng Liaw

MR1035-1387



COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Der-Jang Liaw :
Serial No. : 10/777,054 : Art Unit #1713
Filed : 13 February 2004 : Examiner: F. M. Teskin
Title : FUNCTIONAL NORBORNENES AS
INITIATORS FOR RADICAL POLYMERIZATION,
THEIR POLYMERIC DERIVATIVES AND A
PROCESS FOR PRODUCING THE SAME

DECLARATION OF DER-JANG LIAW; CHING-CHENG HUANG; JING-YANG JU;
AND JIUN-TYNG LIAW IN SUPPORT OF A REQUEST FOR DELETION OF
INVENTORS RESPONSIVE TO CANCELLATION OF CLAIMS

Mail Stop NO FEE
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We, Der-Jang Liaw; Ching-Cheng Huang; Jing Yang Ju; and Jiun-Tyng Liaw,
hereby declare as follows:

- (1) That we are the actual inventors of the above-referenced patent application
as filed at the U.S. Patent and Trademark Office;
- (2) That the patent application was filed with Claims 1-27;
- (3) That a Restriction Requirement was issued by the U.S. Patent and
Trademark Office on 22 March 2006;
- (4) That Claims 1-5 were elected for further prosecution in this patent
application;
- (5) That the actual inventors of Claims 1-5 in the above-referenced patent
application are Der-Jang Liaw and Ching-Cheng Huang;

(6) That it is requested that the inventors, Jing-Yang Ju and Jiun-Tyng Liaw, be deleted from the patent application with respect to the further prosecution of Claims 1-5;

(7) That a check in the amount of \$130.00 is attached to the Amendment accompanying this Declaration for payment of the processing fee set forth in Section 37 CFR 1.17(i).

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

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